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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,221	06/21/2002	Lawrence Miller	36287-03500	4472

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EXAMINER
SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 June 2002</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>21 June 2002</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Drawings

1.   The drawings are objected to because they are handwritten in places. Corrected drawing sheets

in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the

application. Any amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the

remaining figures must be renumbered and appropriate changes made to the brief description of the

several views of the drawings for consistency. Additional replacement sheets may be necessary to show

the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to

37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not

be held in abeyance.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1-2 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s),

at the time the application was filed, had possession of the claimed invention. A key element of claims 1

and 8-10 is the phrase *determining whether the request includes a token* [cookie]. Upon careful

consideration of the specification, no portion of the specification can be located that deals with including a *token* [cookie] in the request from the client to the server. It is unknown why the client would be transmitting a *token* [cookie] to the server when the invention instead seems to be directed to retrieving said *token* [cookie] from said server. The problem with claim 1 carries into claim 2, where *making a record that the client has the token* is directly dependent upon the step of *determining whether the request includes a token*.

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.   Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.   The term "a predetermined value" in claims 5-7 is a relative term which renders the claim indefinite. The term "a predetermined value" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification makes a possible suggestion of this predetermined value in paragraph [0018], but one of ordinary skill in the art would be unsure if this actually applies to the invention as claimed based on his reading of the specification, in particular paragraph [0018] on page 3 of the specification.

7.   Claims 1 and 8-10 refer to *the token is created responsive to an earlier request from the client to the server*. It is unclear what the intended metes and bounds of this phrase are.

8.   Claims 1-10 all consist of claims containing the equivalent of "if...then..." statements. This type of statement does not clearly define what is included and not included within the invention.

Claim Rejections - 35 USC § 101

9.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10.   Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 refers to *Computer executable software code transmitted as an information signal.* This computer code is not embodied on any tangible medium, and therefore is non-statutory.

11.   Claim 9 is statutory solely because the specification, page 4, paragraph [0020] has defined the *computer readable medi*[a] as *removable and fixed software code storage media.* This is interpreted as being tangibly bodied storage media, and not constituting any signals, carrier waves, or other intangible embodiments. Applicant is put on notice of this fact before any potential amendments are made to the claims and/or specification to overcome the 101 rejection.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Montulli (U.S. Patent No. 5,774,670).

3.   In regard to claims 1 and 8-10, Montulli disclosed *sending a request from a client to a server; determining whether the request includes a token; and if the token is not included in the request, determining whether the token is available to send to the client, wherein the token is created responsive to an earlier request from the client to the server.* See Montulli, column 7, lines 11-27.

4.   In regard to claim 2, Montulli is applied as in claim 1. Montulli further disclosed *if the token is included in the request, making a record that the client has the token.* See Montulli, column 9, lines 31-46.

5.   In regard to claim 3, Montulli is applied as in claim 1. Montulli further disclosed *if the token is available to send to the client, sending a response to the client with the token.* See Montulli, column 7, lines 11-27.

6.   In regard to claim 4, Montulli is applied as in claim 1. Montulli further disclosed *if the token is not available to send to the client, sending a response to the client without the token.* See column 7, lines 1-7. See column 7, line 12, which shows the cookie as an <u>extension</u> to the HTTP protocol.

7.   In regard to claim 5, Montulli is applied as in claim 1. Montulli further disclosed *determining if a timer exceeds a predetermined value.* See Montulli, column 12, lines 57-67, column 8, lines 15-31, and column 9, lines 31-46.

8.   In regard to claim 6, Montulli is applied as in claim 5. Montulli further disclosed *if the timer does not exceed the predetermined value, determining whether the token is available to send to the client.* See Montulli, column 8, lines 15-31. See Montulli, column 12, lines 57-67.

9.   In regard to claim 7, Montulli is applied as in claim 5. Montulli further disclosed *if the timer does exceed the predetermined vale, sending a response to the client without the token.* See Montulli, column 8, lines 15-31. See Montulli, column 12, lines 57-67.

Double Patenting

10.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11.   Claims 1 and 5 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-3 of copending Application No. 10/064,118. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Application 10/064,221 is in *italics*. Application 10/064,118 is in **bold**.

Claim 1: *A method for providing information to a client browser* (**A method for providing information to a client browser**), *the method comprising: sending a request from a client to a server* (**sending a first request from a client to a server**)*; determining whether the request includes a token* (**responsive to the first request, initiating a request by the server to create a token**)*; and if the token is not included in the request, determining whether the token is available to send to the client, wherein the token is created responsive to an earlier request from the client to the server.* (**sending a second request from the client to the first link, the second request not including the token; determining at the first link whether the token is created; and if the token is created, sending the token to the client**).

Claim 5: *determining if a timer exceeds a predetermined value.* (**claim 2: starting a timer after initiating the request to create a token. claim 3: if the token is not yet created, comparing the timer to a predetermined value**)

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McElfresh et al.	U.S. Patent No. 6,907,566
Shi et al.	U.S. Patent No. 5,875,296

Kirsch   U.S. Patent No. 5,963,915

Gardenswartz et al.   U.S. Patent No. 6,055,573

Rosenberg et al.   U.S. Patent No. 6,073,241

Bryant et al.   U.S. Patent No. 6,078,956

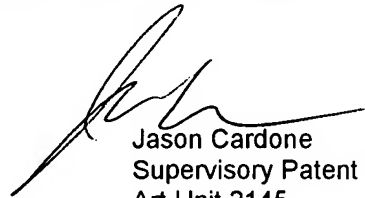Massarani et al.   U.S. Patent No. 6,751,654

Nelte, Michael and Elton Saul. "Cookies: weaving the Web into a state". Crossroads, vol. 7,

issue 1. Fall 2000. pp. 10-13. ACM Press.

Kriston, David M. "HTTP Cookies: Standards, privacy, and politics". ACM Transactions on

Internet Technology, vol. 1, issue 2. November 2001. pp. 151-198. ACM Press.

Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can

normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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at 866-217-9197 (toll-free).

Jason Cardone
Supervisory Patent Examiner
Art Unit 2145